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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No : 10/005,052
Applicant : Monsalve-Gonzalez et al.
Filed : December 4, 2001
Title : Bran and Bran Containing Products of Improved Flavor
and Methods of Preparation

TC/A.U. : 1761
Examiner : L. Tran
Docket No. : 5553

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper is filed in response to the Final Office Action dated September 19, 2007 issued in the above-identified U.S. patent application, and accompanies a Notice of Appeal and a Pre-Appeal Brief Request for Review of the rejections presented in the above-identified U.S. patent application.

This Pre-Appeal Brief Request for Review concentrates on:

- 1) the improper rejection of the § 1.132 affidavit filed July 5, 2007; and
- 2) the Examiner's failure to address each and every limitation in the claims.

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1. The improper rejection of the § 1.132 affidavit filed July 5, 2007.

In the Final Office Action of September 19, 2007, the Examiner rejected the § 1.132 Affidavit filed July 5, 2007, for reasons which are both incomplete and inaccurate. More specifically, on page 6 of the Office Action, the Examiner stated that “[t]he declaration does not state that the inventors listed in the WO 02/21936 were not the inventors of the patent; the declaration also does not state how the other inventors contributed to the invention since they were listed on the patent.” It is unclear what the Examiner means by this statement. There is clearly no requirement for the Applicant to state how each inventor contributed to the invention in the WO 02/21936 publication. The relevant part of the M.P.E.P. states that:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim...may submit an appropriate oath or declaration to establish **invention of the subject matter** of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. M.P.E.P. § 715 (emphasis added).

The Affidavit submitted in the present case indicates that the inventors of claimed subject matter were also the inventors of the subject matter in WO 02/21936 that is relied on by the Examiner in her rejection of the current claims under 35 U.S.C. § 102(e). During a telephonic interview with the Examiner on November 7, 2007, the Applicants requested clarification on the meaning of the rejection, at which time the Examiner stated that she was not clear on the rejection, but was told by an “expert” that she should reject the Affidavit. As the undersigned has successfully filed similar affidavits in the past and the Examiner could not explain the position taken in the Office Action, it is respectfully submitted that the rejection of the § 1.132 Affidavit for the reasons given is a clear error.

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2) **The Examiner's failure to address each and every limitation in the claims.**

Claims 1-3, 5-9 and 16-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,844,924 to Stanley in view of U.S. Patent No. 4,372,812 to Phillips et al. The present invention is directed to bran having a reduced ferulic acid concentration and an elevated vanillin concentration, as well as a method of producing the same utilizing a mild ozone oxidation treatment. Neither Stanley nor Phillips et al. addresses decreasing ferulic acid while increasing vanillin content in bran. In contrast, Stanley is concerned with a method of decreasing the color of dietary fiber material by reacting the material with an esterifying agent and then bleaching the fiber material. Stanley notes that typical bleaching agents can be utilized, such as peroxides, chlorites, peracids and ozone. However, Stanley does not teach an increase in vanillin concentration, utilizing ozone exclusively, or the concentration of ozone required to increase vanillin as is required by the present invention. Instead, examples provided in Stanley include bleaching bran with peracetic acid or hydrogen peroxide for no less than 120 minutes at one time. See columns 4-7 of Stanley.

The Examiner also cites Phillips et al. stating that it would have been obvious to one skilled in the art to determine the amount of ozone to be used based on the bleaching range in Phillips. However, Phillips et al. is directed to a process for **bleaching lignocellulosic pulp**. Phillips et al. does not teach an increase in vanillin concentration, nor does it teach the concentration of ozone required to increase vanillin concentrations as is required by the present invention. Regardless, there is simply no reason for one of ordinary skill in the art to apply the concentration of ozone from one step in the pulp-bleaching process of Phillips et al. to Stanley and yet forgo the required hydrogen peroxide bleaching step in Phillips et al. Furthermore, Phillips et al. is in a completely different field than both Stanley and the present invention, and there is simply no motivation, suggestion or teaching to combine references from entirely different fields to solve a problem that neither one of them recognizes or addresses, i.e., the reduction of ferulic acid concentrations and increase of vanillin concentrations in bran.

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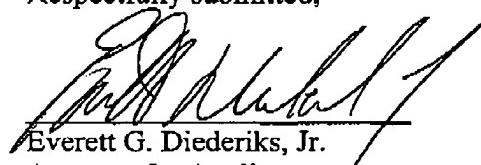
Even if Stanley and Phillips et al. could be properly combined, the combination would not teach or suggest utilizing a mild ozone oxidation treatment to reduce ferulic acid and increase vanillin in bran, let alone the specifically claimed treatment with 0.1 to 1 parts ozone per 100 parts bran and/or a finished ferulic acid concentration of less than 30 ppm in conjunction, with an elevated concentration of vanillin. In fact, both Stanley and Phillips et al. teach the use of multiple bleaches, thus teaching away from the present invention. Stanley teaches that peracetic acid and/or hydrogen peroxide are preferred bleaches, while Phillips et al. only discusses the use of ozone for bleaching in conjunction with hydrogen peroxide bleaching. In other words, one of ordinary skill in the art would not find it apparent to apply only the ozone portion of a three-part pulp bleaching process (Phillips et al.) to bran based on a reference (Stanley) teaching highly oxidative bleaching using peracetic acid or hydrogen peroxide.

The desirability of a mild ozone oxidation treatment to increase the vanillin level and decrease ferulic acid in bran is clearly not addressed in any of the prior art cited by the Examiner. Instead the Examiner simply states "reducing ferulic acid and increasing vanillin are an obvious result of the reaction of bran with ozone" and "such properties will also be found in the Stanley product." See page 3 of the Office Action. This is simply not the case. The present invention offers a milder oxygenation treatment of bran than the hydrogen peroxide bleaching method of the prior art, resulting in elevated vanillin levels. The Applicant clearly sets forth the importance of the ozone range claimed in the subject application. Insufficient ozone can result in higher levels of ferulic acid remaining in the treated bran, while excessive ozone will drive the oxygenation process so far that desirable vanillin is destroyed. See pages 14 and 15 of the application. Prior art bleaching drives the oxygenation process of the bran beyond what is desirable. More specifically, too much oxygenation leads to the destruction of desirable vanillin. Therefore, the Examiner's assertion that reduced ferulic acid and increased vanillin would be found in the Stanley product is simply not true and certainly not supported by the Stanley disclosure.

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Based on the above, it is respectfully submitted that the § 1.132 Affidavit should be entered, the prior art rejections be withdrawn, the claims allowed and the application passed to issue. The Examiner is cordially invited to contact the undersigned if there exist any remaining issues which could be readily resolved in order for the application to properly proceed to allowance in a timely manner.

Respectfully submitted,



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